

IN THE UNITED STATES DISTRICT COURT  
FOR THE SOUTHERN DISTRICT OF TEXAS  
HOUSTON DIVISION

WESTERN FALCON, INC. and  
WAGON TRAIL VENTURES, INC.

Plaintiffs,

vs.

MOORE ROD & PIPE, LLC and  
MOORE PIPE INC.

Defendants.

Case No. 4:13-cv-02963

JURY DEMANDED

**AMENDED AGREED ORDER OF STAY AND INJUNCTION**

Plaintiffs Western Falcon, Inc. (“Western Falcon”) and Wagon Trail Ventures, Inc. (“Wagon Trail”) (collectively “Plaintiffs”) and Defendants Moore Rod & Pipe, LLC (“MRP”) and Moore Pipe Inc. (“MPI”) (collectively “Defendants”), after a hearing before the Court on October 29, 2014, and conferring amongst themselves through counsel, have jointly submitted this Amended Agreed Order of Stay and Injunction (“Amended Agreed Order”) for entry by the Court, as follows:

WHEREAS, Plaintiffs filed the complaint against Defendants in this case on October 8, 2013 [Doc. 1], alleging seven causes of action and in their prayer for relief have requested monetary and injunctive relief;

WHEREAS, Defendants filed Answers and Counterclaims [Docs. 9 & 10], in which they, *inter alia*, denied Plaintiffs’ allegations and any monetary or injunctive relief;

WHEREAS, Defendants moved to stay this litigation pending resolution of an *inter partes* review (“IPR”) proceeding currently pending before the Patent Trial and Appeal Board,

Case IPR2013-00418, Patent RE 36,362, *Moore Rod & Pipe, LLC v. Wagon Trail Ventures, Inc.* (“IPR Proceeding”) [Doc. 7]. Plaintiffs filed their response in opposition [Doc. 11] and filed a motion for preliminary injunction [Doc. 22]. Defendants filed a response in opposition [Doc. 23] to the motion for preliminary injunction to which Plaintiffs filed a reply [Doc. 31];

WHEREAS, after a hearing on January 30, 2014, this Court entered an Agreed Order of Stay and Injunction [Doc. 34] on February 4, 2014 (“Agreed Order”), which included subparts (a-e) of Paragraph 2 (referred to therein as “the Preliminary Injunction”);

WHEREAS, the Patent Trial and Appeal Board issued its Final Written Decision on October 2, 2014, finding that Plaintiffs’ claims 1-20 of U.S. Patent No. 36,362 (the “’362 Patent”) are unpatentable;

WHEREAS, Defendants filed Defendants’ Motion to Lift Stay and Dissolve Preliminary Injunction (Doc. 42) on October 7, 2014. Plaintiffs filed Plaintiffs’ Response to Defendants’ Motion to Lift Stay and Motion to Dissolve Preliminary Injunction (Doc. 49) on October 27, 2014;

WHEREAS, Patent Owner Wagon Trail Ventures, Inc. filed a Request for Rehearing Pursuant to 37 C.F.R. § 42.71(d) in the IPR Proceeding on October 27, 2014;

THEREFORE, the Court, having given full consideration to all of the papers, evidence, and testimony submitted by both sides, arguments of counsel, the relevant authorities, and the Federal Rules of Civil Procedure, makes the following Order.

IT IS HEREBY ORDERED AND ADJUDGED as follows:

1. This Court has subject matter jurisdiction under 28 U.S.C. §§ 1331, 1367, 2201, and 2202; 15 U.S.C. §§ 1051 *et seq.*; and 35 U.S.C. § 101 *et seq.*

2. This Court has personal jurisdiction over Defendant MRP by virtue of its Texas citizenship and its transactions of business in this Judicial District. Further, MRP submitted itself to this Court's jurisdiction by asserting counterclaims.
3. This Court has personal jurisdiction over Defendant MPI by virtue of its transactions of business in this Judicial District in connection with the subject matter of this litigation. Further, MPI submitted itself to this Court's jurisdiction by asserting counterclaims.
4. Plaintiff Wagon Trail Ventures, Inc. owns the '362 Patent, and Plaintiff Western Falcon, Inc. has the exclusive license to the '362 patent.

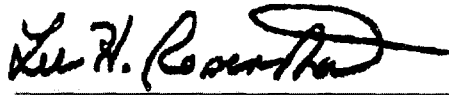
IT IS THEREFORE FURTHER ORDERED that:

1. Subparts (b) and (c) of Paragraph 2 of the Agreed Order are hereby dissolved, but subparts (a), (d), and (e) are not dissolved and remain in place, and the remainder of the Agreed Order is replaced and superseded by this Amended Agreed Order ;
2. The stay previously ordered by this Court on February 4, 2014, is temporarily lifted for the sole purpose of entering this Amended Agreed Order (without triggering any estoppel that was referenced in the Agreed Order);
3. Upon entry of this Amended Agreed Order, this case is hereby stayed until December 7, 2014, at which time the stay will lift automatically without further order of this Court. Further, the following motions filed during the stay of this case will be deemed filed on December 7, 2014, and any responses to these motions will be due within the time periods set forth in the Southern District of Texas' Local Rules: (1) Defendants' Motion for Summary Judgment and Motion for Award of Attorney's Fees [Doc. 43]; and (2) Plaintiffs' Unopposed Motion for Protective Order [Doc. 50]. This case shall remain administratively closed for the duration of the stay;

4. Upon Final Resolution of the IPR Proceeding, each and every party to this case agrees that they will each be estopped from asserting or maintaining claims or defenses which were, or could have been, asserted in the IPR Proceeding. “Final Resolution” of the IPR Proceeding will occur once a certificate, as described in 37 C.F.R. § 42.80, is issued and published (the “Certificate”). The parties shall file a joint notice of such issuance and publication of the Certificate with the Court within 7 days of Final Resolution of the IPR Proceeding. The notice shall advise the Court of the results and status of the IPR Proceeding. Further, the notice shall attach a copy of the certificate described in 37 C.F.R. § 42.80. Notwithstanding the fact that this case will be stayed, nothing about this Order precludes either party from immediately filing, during the stay, a motion to address potential violations of the Amended Preliminary Injunction or this Court from enforcing the Amended Preliminary Injunction during the stay.
5. Defendants MRP and MPI, their officers, agents, servants, employees, parents, subsidiaries and related companies, and all persons acting for, with, by, through or under them having notice of this Order by personal service, electronic mail, or otherwise, and each of them, shall be immediately preliminarily enjoined and restrained from:
  - a. Advertising or otherwise making statements to actual or potential customers that MRP’s Shur-Flo SF3 product will withstand working temperatures between 350 to 400 degrees F [Fahrenheit] or words of similar import;
  - b. With actual knowledge hiring any current or former employees of Plaintiffs who have executed a written non-compete agreement with either or both of Plaintiffs, until the term of any such non-compete agreement has expired or is found to be unenforceable by a court of competent jurisdiction; and

- c. Obtaining or using any of Plaintiffs' trade secrets specifically related to the '362 patent.
  - d. The restraints ordered in this paragraph and its subparts (a–d) shall be referred to hereinafter as “the Amended Preliminary Injunction.”
6. Given the agreed nature of the injunctive relief being granted, the parties waive the bond requirements set forth in Federal Rules of Civil Procedure 65(c) and (d). Further, all objections to the form of this Order, its enforceability, and/or its compliance with the Federal Rules of Civil Procedure are hereby waived by the parties. Other than the findings and conclusions contained herein, the parties agree and stipulate that this Order shall be entered without findings of fact and conclusions of law and waive all rights to request such findings or conclusions.

Signed this <sup>4th</sup> ~~day of October~~ <sup>November</sup>, 2014.



HON. LEE H. ROSENTHAL  
UNITED STATES DISTRICT JUDGE

Respectfully submitted,

By: //s// George A. Kurisky, Jr.  
GEORGE A. KURISKY, JR.  
SBT No: 11767700  
gkurisky@jdgklaw.com

OF COUNSEL:

**JOHNSON DELUCA KURISKY & GOULD**  
**A Professional Corporation**

Daniel J. Kasprzak  
Texas Bar No. 11105300  
dkasprzak@jdgklaw.com  
Mark A. Bankston  
Texas Bar No. 24001430  
mbankston@jdgklaw.com  
4 Houston Center, Suite 1000  
1221 Lamar Street  
Houston, Texas 77010  
(713) 652-2525 – Telephone  
(713) 652-5130 – Facsimile

**ATTORNEYS FOR DEFENDANTS,**  
**MOORE ROD & PIPE, LLC and MOORE PIPE INC.**

Respectfully submitted,

By: //s// Douglas H. Elliott  
DOUGLAS H. ELLIOTT  
SBT No: 00653900  
delliott@elliottiplaw.com

OF COUNSEL:

**THE ELLIOTT LAW FIRM**

Eric M. Adams  
Texas Bar No. 24031686  
eric@elliottiplaw.com  
Sylvia Ngo  
Texas Bar No. 24067100  
Sylvia@elliottiplaw.com  
Frost Bank Building  
6750 West Loop South, Suite 995  
Bellaire, Texas 77401  
(832) 485-3508 – Telephone  
(832) 485-3511 – Facsimile

Dale Jefferson  
Martin, Disiere, Jefferson & Wisdom, LLP  
Texas Bar No. 10607900  
Jefferson@mdjwlaw.com  
808 Travis, 20th Floor  
Houston, Texas 77002  
(713) 632-1700 – Telephone  
(713) 632-0101 – Facsimile

**ATTORNEYS FOR PLAINTIFFS**